AF SDFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No. **020431.0671**

In re Application of:	§	
	§	
MUKESH DALAL	§	Examiner:
	§	
Serial No. **09/528,457**	§	**STEVEN B. MCALLISTER**
	§	
Filed: **17 MARCH 2000**	§	Art Unit: **3627**
	§	
For: **SYSTEM AND METHOD FOR MULTI-PARTY CONSTRAINED OPTIMIZATION**	§	Confirmation No.: **4373**
	§	
	§	

TRANSMITTAL

MAIL STOP: APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Please file the following enclosed documents in the subject application:

1. This Transmittal with Certificate of Mailing;
2. Reply Brief; and
3. Our return postcard which we would appreciate you date stamping and returning to us.

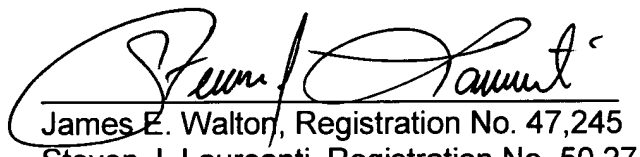
CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8(a)
Date of Deposit: 7/13/06
I hereby certify that this paper or fee is being deposited with the United States Postal Service as First Class Mail with sufficient postage under 37 C.F.R. §1.8(a) on the date indicated above and is addressed to Mail Stop: APPEAL BRIEF - PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.
By: _____

Although the Appellant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing the Reply Brief to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

7/13/06
Date



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REPLY BRIEF

MAIL STOP: APPEAL BRIEF - PATENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant respectfully submits this Reply Brief under 37 C.F.R. § 41.41(a)(1) in response to the Examiner's Answer mailed 19 May 2006.

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By:

REMARKS:

The Appellant filed an Appeal Brief on 6 March 2006 explaining clearly and in detail why the final rejection of Claims 1-3, 5-7, 10-15, 17-19, 21-23, 26-31, 33-35, 37-39, and 42-63 is improper and the Board should reverse this final rejection. As explained in more detail below, the Examiner's final rejection of these claims cannot be properly maintained. Appellant respectfully requests the Board to reverse this final rejection and instruct the Examiner to issue a Notice of Allowance with respect to these claims.

Appellant's Claims are Allowable Over the Cited References

Section 5 of the Examiner's Answer alleges that the "summary of claimed subject matter contained in the brief is deficient." The Appellant respectfully disagrees. The Appellant respectfully submits that the summary of the claimed subject matter contained in the Appeal Brief filed on 6 March 2006 is in full compliance with 37 C.F.R. § 41.37(c)(1)(v).

Section 9 of the Examiner's Answer consists entirely of material repeated verbatim from the Final Office Action mailed 27 January 2004. Section 10 of the Examiner's Answer consists of six sections, i.e. sections A-F. The first, second, third, and fourth sections consist of substantially new material responding to arguments in Appellant's Appeal Brief, while the fifth and sixth sections consists entirely of referring the reader to previous sections of the Examiner Answer. Below, Appellant's specifically address the new material in the first, second, third, and fourth sections of Section 10 of the Examiner's Answer.

In the first section, section A, of Section 10 of the Examiner's Answer, the Examiner asserts that *Lupien* and *Thiessen* "show dividing the excess above the threshold values such that the first excess is equal to the second excess according to an equal distribution criterion" and that, therefore, *Lupien* and *Thiessen* disclose ***the global solution representing a first excess between the first objective value and the first threshold value and a second excess between the second objective value and the second threshold value, the global solution being generated considering a***

fairness criterion, as recited in Appellant's independent claims. Appellant respectfully disagrees with the Examiner. In fact, the Examiner acknowledges and the Appellant agrees that *Lupien* fails to show "dividing the excess satisfaction between the threshold, 0.1 and the values at which the trade takes place". However, the Examiner asserts that *Thiessen* discloses the acknowledged shortcomings in *Lupien*. Contrary to the Examiner's assertion, *Thiessen* does not disclose "distribution of equal distribution of excess satisfaction." In fact, nowhere does *Thiessen* even suggest anything regarding excesses corresponding to thresholds which are to be fairly distributed to the parties according to a particular fairness criterion. Thus, *Thiessen* fails to disclose, teach, or suggest ***the global solution representing a first excess between the first objective value and the first threshold value and a second excess between the second objective value and the second threshold value, the global solution being generated considering a fairness criterion,*** as recited in Appellant's independent claims.

Also, in the first section, section A, of Section 10 of the Examiner's Answer, the Examiner also asserts that *Lupien* "shows all elements except those noted in the rejection and shown by *Thiessen*," which the Examiner indicates supports the Examiner's assertion that *Lupien* and *Thiessen* disclose ***a first optimization problem and a first threshold value corresponding to a first party to a negotiation, the first optimization problem comprising at least one first objective to which the first threshold relates and one or more first constraints to which the at least one first objective relates and a second optimization problem and a second threshold value corresponding to a second party to a negotiation, the second optimization problem comprising at least one second objective to which the second threshold relates and one or more second constraints to which the at least one second objective relates***, as recited in Appellant's independent claims. Appellant respectfully disagrees with the Examiner. Contrary to the Examiner's assertion, the stock price disclosed in *Lupien* does not have anything to do with or is not even related to "***one or more first constraints or one or more second constraints***", as recited in Appellant's independent claims. Nowhere does *Lupien* disclose a "***one or more first constraints or one or more second constraints***", as recited in Appellant's independent claims. Therefore, *Lupien* cannot provide for ***a first optimization problem and a first***

threshold value corresponding to a first party to a negotiation, the first optimization problem comprising at least one first objective to which the first threshold relates and one or more first constraints to which the at least one first objective relates and a second optimization problem and a second threshold value corresponding to a second party to a negotiation, the second optimization problem comprising at least one second objective to which the second threshold relates and one or more second constraints to which the at least one second objective relates, since *Lupien* does not suggest, teach or even hint at "***one or more first constraints or one or more second constraints***", as recited in Appellant's independent claims.

In the second section, section B, of Section 10 of the Examiner's Answer, the Examiner asserts that, in *Lupien* and *Thiessen,* "communicating the solution to the parties" and "receiving filtering information from the parties" and using "the filtering information to determine the global solutions." Appellant's respectfully disagree with the Examiner. In addition, the Examiner further asserts "it is not true that it matters when the filter terms are provided." However, contrary to the Examiner's assertions, it is axiomatic that filtering of global solutions must be performed after the global solutions have been generated, as pointed out with specificity in the Appeal Brief filed on 6 March 2006.

In the third section, section C, of Section 10 of the Examiner's Answer, the Examiner asserts that, "claims 13, 29, 45, and 48-50 [...] were included under the heading of this rejection only inadvertently" and "only claims 24, 30, and 46 contain the element treated in this rejection." As such, the Examiner acknowledges and the Appellant's agree that the rejection of claims 13, 29, 45, and 48-50 are improperly rejected under section C of Section 10 of the Examiner's Answer.

The Examiner further asserts, with respect to claims 14, 30, and 46 that, "official notice that using an auction as a selection method is old and well known." Appellant respectfully disagrees with the Examiner. However, what the Examiner actually asserted was that *Thiessen*:

> Does not disclose choosing the solution via an auction approach. However, it is notoriously old and well known to use an auction to decide the owner of a particular right (in this case the right to choose the final solution). It would have been obvious to one of ordinary skill in the art to modify the method of *Thiessen* by auctioning the right to select from the acceptable, optimized solutions in order to efficiently assign the right by providing it to the party that values it most highly. (30 July 2006 Office Action, Page 7).

In response, to the above Examiner's conclusory statement, the Appellant asserted:

> The Examiner admits that *Thiessen* 'does not disclose choosing the solution via an auction approach.' (cite omitted). Applicant respectfully submits that there is there is no motivation to modify Thiesssen to include these features, if such were even possible, especially in light of the stringent standards for doing so set forth above. Applicant again respectfully notes that a conclusory statement, necessarily involving speculation in hindsight, that 'it would have been obvious' is insufficient under the M.P.E.P. and governing Federal Circuit case law. Accordingly, Applicant respectfully requests reconsideration and allowance of Claims 13-14, 29-30, and 45-46. (30 October 2002, Response to Office Action, Pages 21-22).

Even assuming for the sake of argument that the above Examiner's conclusory statement is Official Notice, which it is not, it is clearly not. The Appellant respectfully submits that the Appellants assertion dated 30 October 2002 is at least an "apparent attempt" to traverse the Examiner's alleged Official Notice.

In the fourth paragraph of Section 10 of the Examiner's Answer, the Examiner asserts that the proposed *Lupien-Thiesse* combination, on which the Examiner relies to reject Claims 1-3, 5-7, 10, 15, 17-19, 21-23, 26, 31, 33-35, 37-39, 42, and 47, is proper. Appellant respectfully disagrees with the Examiner. The Examiner merely states that since "*Thiessen* and *Lupien* show all elements of the claim and since motivation was provided and is supported concretely by *Lupien*, the examiner belies that the rejection is proper". Such statements fail to demonstrate that *Lupien, Thiessen,* or knowledge that was generally available to a person having ordinary skill in the art at the time of the invention would have provided any teaching, suggestion, or motivation to even attempt—much less actually—combine the references with each other as proposed. Actual

evidence of such a teaching, suggestion, or motivation is clearly required by the M.P.E.P. and governing Federal Circuit case law, as discussed at length in Appellant's Appeal Brief and reiterated here. The Examiner's failure to provide the required evidence is fatal to the Examiner's rejections based on the proposed *Lupien-Thiessen* combination.

For at least these reasons, Appellant's claims are patentable over the cited references. The Appellant respectfully submits that the rejection of Appellant's claims is improper and the Board should reverse this rejection.

CONCLUSION:

The Appellant has demonstrated that the present invention, as claimed, is clearly patentable over the prior art cited by the Examiner. Therefore, the Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

Although the Appellant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**.

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Respectfully submitted,

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